

REMARKS

Prior to entry of this Response, Claims 1-4 and 7-11 were examined on their merits while Claims 5-6 and 12-14 were withdrawn from consideration by the Examiner as being drawn to a non-elected species. Claims 15-19 were withdrawn from consideration as being drawn to non-elected inventions. Claims 1, 4, 7, and 13 are currently amended, Claims 20-29 are added, and Claims 2, 3, 5, 6, 12, and 14 are cancelled. After entry of this Response, Claims 1, 4, 7-11, 13, and 15-29 are pending. Applicant reserves the right to file further applications to claims not currently pursued herein.

Amendments to the claims are supported throughout the specification and particularly on pages 10 and 12.

Rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 112, first paragraph (new matter rejection)

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 112, first paragraph as containing new matter, because the Examiner stated that Claim 1 of the Preliminary Amendment introduced the phrase “wherein the solid polymer particles are mechanically stable and are suspended in a liquid carrier substrate,” which the Examiner found to be new matter. Applicant respectfully traverses this rejection, but nonetheless, to further prosecution, Applicant has amended the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

Rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 112, first paragraph (written description rejection)

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 112, first paragraph “as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Applicant respectfully traverses this rejection, but nonetheless, to further prosecution, Applicant has amended the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

Rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 112, first paragraph (enablement rejection)

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 112, first paragraph, because the Examiner found that the specification “does not reasonably provide enablement for solid polymer particles that are less than sixty μm ,” although the Examiner concedes that the specification is “enabling for solid particle polymers that are larger than sixty μm .” (Office Action, Paper 8, page 7). To further prosecution, Applicant has currently amended the claims to claim biocompatible micronized textured polyethylene particles having a size greater than sixty microns. Therefore, Applicant requests that the Examiner withdraw his rejection.

Rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 112, second paragraph

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 112, second paragraph, because the term “liquid carrier substrate” was found vague and indefinite by the Examiner. Applicant has

amended the claims. Thus, this rejection is moot. Applicant requests that the Examiner withdraw this rejection.

Rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 102(b)

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 102(b) as being unpatentable over “Ersek et al. (Ersek, R.A.; Gregory, S.R., Salisbury, A.V. “Bioplastique at 6 Years: Clinical Outcome Studies”, *Plast. Reconstr. Surg.*, November 1997, 100(6), 1570-1574) (IDS Paper No.2) as evidenced by Ersek et al. (Ersek, R.A., Beisang, A.A. “Bioplastique: A New Textured Copolymer Microparticle Promises Permanence in Soft Tissue Augmentation” *Plast. Reconstr. Surg.* 1991 87, 693-702) (IDS Paper No. 2), the National Honey Board (<http://www.nhb.org/foodtech/tgloss.html>), and Polymer Products from Aldrich, and in further view of Applicant’s specification to demonstrate inherency.” (Office Action, Paper 8, page 10 (emphasis deleted)). Applicant respectfully traverses this rejection.

The Examiner stated that “Bioplastique as set forth by the 1997 Ersek et al reference is ... made from fully polymerized and vulcanized methyl-methylpolysiloxane $[(CH_2H)_2-SiO]$ as the solid polymer particles with a size between 100 and 600 μm .” (Office Action, Paper 8, page 11). Applicant’s currently pending claims recite textured polyethylene particles. Ersek et al. (1997) and the references cited by the Examiner do not teach textured polyethylene particles. The Examiner stated that he performed a search for “biocompatible micronized polyethylene,” which “was not found in the prior art.” (Office Action, Paper 8, page 2). Therefore, there are no references found by the Examiner that can teach biocompatible micronized polyethylene particles in a carrier. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

Rejection of Claims 1-4 under 35 U.S.C. § 102(b)

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Bley (EP 0 730 847 A1). The Examiner stated that Bley “discloses ‘[a] physiologically acceptable composition comprising a plurality of physiologically acceptable solid polymer particles dispersed in a physiologically acceptable biodissipatable liquid carrier ... and [the solid polymer particles] being substantially insoluble in the liquid carrier and in body fluids (see Bley, claim 1), which anticipates claims 1-4. Bley goes on to disclose a variety of hydrophilic and hydrophobic solid polymers and liquid carriers.” (Office Action, Paper 8, page 13 (emphasis in original)). Applicant respectfully traverses this rejection. Applicant’s currently pending claims recite textured polyethylene particles. Moreover, the Examiner stated that he performed a search for “biocompatible micronized polyethylene,” which “was not found in the prior art.” (Office Action, Paper 8, page 2). Therefore, Bley does not teach Applicant’s currently claimed invention, nor does any other art found in the Examiner’s search. Applicant respectfully requests that the Examiner withdraw this rejection.

Rejection of Claims 1-4 under 35 U.S.C. § 102(b)

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Freed (U.S. Patent No. 5,480,644). The Examiner stated that Freed discloses that “... [f]luid lubricants may include: hyaluronic acid ... fatty acids ... Biopolymers may include: ... polytetrafluorethylene beads.” (Office Action, Paper 8, page 13). Applicant’s currently pending claims recite textured polyethylene particles. Moreover, the Examiner stated that he performed a search for “biocompatible micronized polyethylene,” which “was not found in the prior art.”

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(Office Action, Paper 8, page 2). Therefore, Freed does not teach Applicant's currently claimed invention, nor does any other art found in the Examiner's search. Applicant respectfully requests that the Examiner withdraw this rejection.


CONCLUSION

The foregoing is a complete response to the Office Action mailed July 16, 2003. Applicant respectfully submits that Claims 1, 4, 7-11, 13, and 20-29 are patentable. Early and favorable consideration is solicited.

No fees are believed due; however, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 20-1507.

If Examiner believes there are other issues that can be resolved by a telephone interview, or there are any informalities that remain in the application which may be corrected by the Examiner's amendment, a telephone call to the undersigned attorney at (404) 885-3652 is respectfully solicited.

Respectfully submitted,



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